

REMARKS

United States Serial No. 10/525,189, was filed on November 7, 2005. In view of amendments and remarks set forth herein, Applicants respectfully request reconsideration of the application and the issuance of a formal Notice of Allowance directed to claims 23-39 and 41.

35 U.S.C. § 112

Claim 41 has been rejected under 35 U.S.C. § 112, second paragraph. Claim 41 has been amended for clarity in order to address the Office's allegation that it is unclear as to if the claim is referring to the dispersion during or after blending, or before, during or after gasifying.

The Office also alleges that "the term 'ambient temperature' is a relative term which renders the claim indefinite. . . . the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention." Applicants respectfully submit that the Office has mischaracterized the present application.

At page 3, lines 25-27 of the present application (emphasis added), it is stated that "the fat powder is returned to ambient temperature, or the temperature of the ice cream making process". Therefore, the present application does provide a standard for ascertaining the requisite degree, and a person of ordinary skill in the art is reasonably apprised of the scope of the claim. Applicants respectfully request that this rejection be withdrawn.

Applicants wish to note that the Office also alleges that Applicants have provided an example of ambient temperature on page 6 of the specification; this is not the case. The example on page 6 of the specification is an example of sub-ambient temperatures, as is clear from the plain meaning of the application at page 6, lines 23-24.

35 U.S.C. § 103

Claims 23-33, 37, 39 and 41 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 0 147 483 to Delany, et al. ("Delany") in view of U.S. Patent Application Publication No. 2001/0038872 A1 to Brooker ("Brooker"). Applicants respectfully traverse this rejection.

The Office alleges, at page 3 of the Office Action, that "[a]s Delany teaches that the fat is crystallized prior to gasification and freezing, Delany teaches that the fat is precrystallized, i.e., crystallized before." Applicants respectfully submit that the Office is using the term "precrySTALLISED" in a manner which is inconsistent with how that term is used in the present application, in contravention of 35 U.S.C. § 112, which provides by implication that an applicant will be his or her own lexicographer. *See* MPEP § 2173.01.

Applicants respectfully submit that Delany does not teach the use of precrystallised fat particles to manufacture ice cream, as that term is defined in the present application. As used throughout the present application, precrystallised refers to fat that is crystallised prior to blending with aqueous ice cream precursor phase in the presence of an emulsifier in order to form a dispersion. *See* page 2, lines 13-24 of the present application. By direct contrast, Delany unequivocally teaches mixing water, uncrystallised fat (which is only subsequently crystallised in a typical ice cream making process), protein and an emulsifier to form an oil-in-water emulsion. This emulsion is then subjected to homogenising and ageing.

Delany nowhere uses the term "precrySTALLISE". Instead, Delany specifically teaches that crystallisation occurs during ageing of the mix of frozen food product ingredients, which is standard in traditional ice cream making processes. Thus, a person of ordinary skill in the art would understand that the term "precrySTALLISE" as used in the present application means that the fat is crystallised prior to combining with the other ice cream ingredients to create an emulsion.

This interpretation of the term “precrystallise” is confirmed in the present application, at page 5, lines 17-22:

A positive advantage of the method according to the invention is that the disperse fat phase (i.e. the precrystallised particles of edible fat) can be prepared and conveniently stored as a stable powder until it is needed and then added either a) to the prepared aqueous phase or b) to other, dry ingredients of the ice cream mix followed by the addition of water and high speed mixing.

For the above reasons, a person of ordinary skill in the art would understand that the term “precrystallise” means that the fat is crystallized before blending with any other ice cream ingredients (except, in certain embodiments, an emulsifier), in such a manner that it may be provided in a stable powder form for later use in the food product. The crystallisation in Delany cannot, therefore, be understood to mean “precrystallisation” as that term is used in the present application.

The Office further alleges, at page 8 of the Office Action, that “it is noted that the features upon which applicant relies (i.e., a definition of precrystallisation which defines the step to which the crystallization is prior to) are not recited in the rejected claim(s).” The term “precrystallised” is defined in the present specification. Therefore, Applicants respectfully submit that further defining language need not be explicitly repeated in the claim.

As discussed in Applicants’ previous Responses, Delany teaches a traditional ice cream making process, employing the usual process steps of forming an oil-in-water emulsion of ice cream ingredients and subjecting the emulsion to the typical homogenisation, pasteurisation, ageing and hardening steps. Delany also discloses the criticality of these traditional steps and the near impossibility of altering the traditional process. For example, Delany, at page 7, lines 15-19, discloses that “[i]t has quite unexpectedly been found that the selection and processing steps [of homogenization and aging] of the fat component during the preparation of the aforementioned aerated frozen food products are critical elements in achieving the unique stability of this invention” (emphasis added). Delany, at page 1, lines 29-34, further discloses (emphasis added) that “rigid consumer acceptance criteria, regulatory standards and the complex nature of the interactions which produce a satisfactory product make it extremely difficult to reformulate such aerated frozen products in an attempt to provide improvements.”

Despite the criticality of the steps of fat selection, homogenisation and ageing to achieving the unique stability provided to frozen food products by the invention of Delany, the Office alleges that these steps may simply be ignored. Because of the criticality disclosed by Delany of the steps of selection, homogenisation and ageing, the unique stability of the products of Delany are likely to be sacrificed if the critical steps are circumvented. This conclusion is supported by the last quote in the previous paragraph; Delany teaches that it is “extremely difficult” to alter aerated frozen products to “provide improvements”. For these reasons, a person of ordinary skill in the art, upon reading Delany, would not ignore the homogenisation and ageing steps, because of the criticality of the steps of Delany as well as the teaching in Delany which discloses that it is extremely difficult to improve aerated frozen products.

For these reasons, there is no teaching or suggestion in either Delany or Brooker that combining the references would provide “substantially the same or an improved product”, because, according to the disclosure of Delany, it is unlikely that the uniquely stable product of Delany will be produced without performing the critical steps disclosed by Delany. The only teaching or suggestion that using a precrystallised fat in making a frozen food product such as ice cream would be desirable or successful is in the present application. Applicants respectfully submit that the Office continues to use improper hindsight reasoning.

Applicants also respectfully submit that Delany and Brooker are not properly combinable, because they each teach away from any combination with the other. MPEP § 2145(X)(D)(2) states that “[i]t is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)”. MPEP at 2100-168. Delany discloses the criticality of using a liquid fat and the steps of selection of the fat, homogenisation and ageing. Delany stresses that these process steps are required to achieve the unique product stability which is the result of the process of Delany. Brooker teaches using a precrystallised fat. Combining Delany with Brooker would render homogenisation and ageing obsolete, likely resulting in a frozen food product lacking in the unique stability demanded by Delany. Therefore, Delany teaches away from any combination with Brooker, and vice versa.

For the same reason, Applicants respectfully submit that combining Delany and Brooker would render the method and resulting food products of Delany unsatisfactory for their intended purposes. MPEP § 2143.01(V) states that, “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)”. MPEP at 2100-140.

MPEP § 2142.03 states that “[t]he prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).” Thus, if there is no reasonable expectation of success, a *prima facie* case of obviousness cannot be established. As discussed above, a person of ordinary skill in the art, upon reading Delany, would not look for ways to improve Delany, because of the criticality of the steps of Delany as well as the teaching in Delany which discloses that it is extremely difficult to improve aerated frozen products. Therefore, a person of ordinary skill in the art would not reasonably expect success by removing Delany’s process steps as alleged by the Office. The Office has merely offered a bald conclusion without technical support that using precrystallised fat would achieve the superior stability disclosed in Delany. For all of the above reasons, Applicants respectfully submit that the Office has failed to state a *prima facie* case of obviousness.

The Office alleges, at page 9 of the Office Action, that “[i]t must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant’s disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).”

As discussed above, Delany does not teach or suggest utilizing a precrystallised fat (as that term is used in the present application), because it teaches the criticality of the steps of selecting a particular liquid fat, and homogenising and ageing this particular fat under certain conditions based upon the particular fat selected. Brooker does not disclose that the precrystallised fat disclosed therein can be utilized in frozen food products or ice creams.

Because of the criticality of the steps disclosed in Delany, one of skill in the art would have had no expectation of success in modifying Delany with Brooker as alleged by the Office. Therefore, the only teaching or suggestion of the potential success of using a precrystallised fat in a frozen food product or ice cream is gleaned only from the present application. Therefore, the Office has utilized improper hindsight reasoning in rejecting the present claims as unpatentable over any combination of Delany and Brooker.

Further, Applicants respectfully submit that it is impermissible within the framework of 35 U.S.C. § 103 to pick and choose from any single reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *Lubrizol Corp. v. Exxon Corp.*, 896 F. Supp. 302, 322, 7 USPQ2d 1513, 1527 (N.D. Ohio 1988) (“It is not permissible to pick and choose only so much of any given reference as will support a given position and ignore the reference in its totality.”). Applicants respectfully submit that the allegations found at pages 8-15 of the Office Action improperly pick and chooses those elements of Delany and Brooker which support the Office’s 35 U.S.C. § 103 rejection, and do not consider the disclosures of Delany as a whole, which show the criticality of the process steps of Delany to providing the “unique” product of Delany.

Applicants submit that claim 23 is not taught or suggested by the combination of Delany and Brooker, for the above reasons. Therefore, claims 24-33, 37 and 39-41, which depend from claim 23, are also not taught or suggested. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (“If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” MPEP § 2143.03 at page 2100-142.) For the above reasons, Applicants respectfully request that the rejection of claims 23-33, 37 and 39-41 be withdrawn.

Claims 34-36 and 38 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Delany in view of Brooker, further in view of U.S. Patent No. 4,012,533 to Jonas (“Jonas”). The improper combination of Delany and Brooker, as well as their combination, are discussed in detail above. That discussion is incorporated by reference in its entirety in Applicants’ traversal of the § 103 rejection of claims 34-36 and 38 over Delany, Brooker and Jonas. Jonas merely

discloses suitable edible emulsifiers for making a whippable topping emulsion. As discussed above, Delany and Brooker teach away from their combination, as the combination results from improper hindsight reasoning and impermissible picking and choosing. The selection of a particular emulsifier for inclusion in Delany based on the desired final product proportions does not cure the improper combination Delany and Brooker.

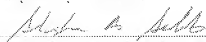
Applicants respectfully submit that claim 23 is not taught or suggested by the combination of Delany, Brooker and Jonas. Applicants submit that, since claim 23 is not taught or suggested by the combination of Delany, Brooker and Jonas, claims 34-36 and 38, which depend from claim 23, are also not taught or suggested. *See In re Fine*. Applicants respectfully request that the rejection of claims 34-36 and 38 be withdrawn.

Applicants have addressed the instant rejections with respect to the independent claim in particular, and have distinguished the applied references as discussed above. It is therefore deemed unnecessary to address specific allegations of the Office Action regarding the dependent claims. Applicants therefore traverse these allegations, and do not concur with the same either explicitly or implicitly by not refuting each individually.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request withdrawal of the 35 U.S.C. §§ 112 and 103 rejections, and issuance of a Notice of Allowability with respect to claims 23-39 and 41. Should the Examiner have any questions about the present submission, the undersigned attorney would welcome a telephone call.

Respectfully submitted,


Joseph G. Curatolo, Esq. (Reg. No. 28,837)
Salvatore A. Sidoti, Esq. (Reg. No. 43,921)
Vincent A. Cortese, Esq. (Reg. No. 63,755)
Curatolo Sidoti Co., LPA
24500 Center Ridge Road, Suite 280
Cleveland, OH 44145
Telephone: 440.808.0011
Facsimile: 440.808.0657
Attorneys for Applicants

Date: April 13, 2010

Correspondence Addressee of Record:
Joshua L. Cohen, Esq. (Reg. No.: 34,307)
Attorney of Record
Linde North America, Inc.
IP Department
575 Mountain Avenue, Building 4 South
Murray Hill, NJ 07974
Phone: (908) 771-6167
Facsimile: (908) 771-6159